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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/671,268	09/24/2003	Ravi Raj	1361032-2273	6536

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EXAMINER	
ALVAREZ, RAQUEL	

ART UNIT	PAPER NUMBER
3682	

MAIL DATE	DELIVERY MODE
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/671,268	RAJ ET AL.	
	Examiner	Art Unit	
	RAQUEL ALVAREZ	3682	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *09 May 2011*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-30* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-30* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *5/9/11*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

1. This office action is in response to communication filed on 5/9/2011.

2. Claims 1-30 are presented for examination.

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Based on Supreme Court precedent [1] and recent Federal Circuit decisions, a 101 process must (1) be tied to another statutory class (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing. [2] If either of these requirements is met by the claim, the method is non a patent eligible process under § 101 and should be rejected as being directed to non-statutory subject matter.

Claims 1-12, 13-16 are rejected under 35 U.S.C. 101 as drawn to a non-statutory subject matter. The applicant is reciting only method steps such as "using….placing…..displaying" the applicant has not recited an apparatus or device to perform these limitations and without apparatus or device these limitations are just mental steps. Mentioning computer in the preamble is not enough, if the body of the claims each of the steps can be performed manually.

Examiner suggests applicant inserts a device in one or more essential steps of the body of the claims in order to overcome this rejection.

[1] Diamond v. Diehr, 450 U.S. 175, 184 (1981); Parker v. Flook, 437 U.S. 584, 588 n.9 (1978); Gottschalk v. Benson, 409 U.S. 63, 70 (1972); Cochrane v. Deener, 94 U.S. 780, 787-88 (1876).

[2] The supreme court recognized that this test is not necessary fixed or permanent and may evolve with technological advances. Gottschalk v. Benson, 409 U.S. 63,71 (1972)

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

5. Claims 1-5, 8-9, 13-15, 17, 12-27 and 30 are rejected under 35 U.S.C. 102(e) as being anticipated by Singh (7,231,258 hereinafter Singh).

With respect to claims 1, 13, 17, 23 and 30 Singh teaches systems and methods for implemented on at least one network device, for placing predetermined content in a result from a sponsored search (abstract). (a)Receiving a budget a time interval, a keyword, a piece of content, and a selection of one of a plurality of methods for calculating bids (col. 9, lines 4-51);

(b) using the selected method, calculating a plurality of bids for [[a]] the keyword, each of the plurality of bids corresponding to one of a plurality of time periods within the time interval, the calculations based on an estimated average cost per click of the keyword for each of the plurality of time periods within the time interval, inferred from historical cost per click data (i.e. table on column 10 takes into account past clicks, past bids and past costs);

An actual number of clicks available for the keyword for each of the plurality of time periods within the time interval (i.e. actual number of click throughs)(col. 11, item 4);

(c) placing each of the plurality of bids on the keyword for the corresponding time period and (d) displaying the piece of content during one of the time periods within the time interval based on the bid placed for that time period (i.e. placing the optimum bids on the keywords corresponding to the content for the suited time period)(col. 13, lines 1 to col. 14, line 60).

With respect to claims 2 and 24, Singh teaches wherein acquiring of the placement of the predetermined content further comprises ranking of the predetermined

content based in part on the value of each bid (i.e. ranking the content corresponding to each bid)(col. 4, lines 16-30),

With respect to claims 3, 14, and 25, Singh teaches the method and program wherein placing the at least one bid further comprises at least one of placing a bid to acquire the placement of predetermined content in at least one of a lower position in the result of the sponsored search, and placing a bid to acquire the placement of predetermined content in at least one of a first three positions in the result of the sponsored search (col. 14 lines 44 to col. 15 lines 30).

With respect to claims 4, 5, 15, 26, and 27, Singh teaches the method and program wherein the at least one selected method includes optimization of the plurality of separate bids based on a cost per acquisition (CPA) method, comprising at least one of minimum cost for maximum acquisitions (col. 7 lines 27-40 and col. 11 lines 48-50). (Note: claims 5 and 27 were not considered, since the first option of minimum cost for maximum acquisitions was selected in claims 4 and 26).

With respect to claims 8 and 9, Singh teaches the method further comprising providing information that is employed by the at least one selected method to place the at least one bid, wherein the provided information further includes start time col. 6 lines 23-36), stop time (col. 6 lines 23-36), and relevant keywords (col. 10 lines 53-57) (Note:

claim 9 was not considered, since the first option of position in ranked list of sponsored search result was selected in claim 8).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

7. Claim 6-7, 16, 18, 20-22 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Singn in view of Davis et al. (6,69,361 hereinafter Davis).

In reference to claim 6, Singh does not teach the method wherein at least one selected method is adds an unused portion of the budget for a time interval to another time interval. Davis teaches the method wherein at least one selected method is adds an unused portion of the budget for a time interval to another time interval It would have been obvious to a person of ordinary skill in the art at the time of the applicant's invention to modify Singh to include the option of adding an unused portion of the budget for a time interval to another time interval to enable the advertiser to reallocate funds instead of having to issue the advertiser a refund for the unused amount.

In reference to claims 7, 16, and 28, Singh does not specifically teach the method and program wherein the keyword further comprises at least one of a provided

keyword, and a generated keyword that is related to the provided keyword and is added to the at least one keyword. Davis teaches the method and program wherein the keyword further comprises at least one of a provided keyword (i.e. advertiser provides the keyword) (col. 5 lines 18-34), and a generated keyword that is related to the provided keyword and is added to the at least one keyword (i.e. system generates synonyms for the advertiser provided keyword and these can be added to the keywords selected by the advertiser) (col. 20 lines 46-65). It would have been obvious to a person of ordinary skill in the art at the time of the applicant's invention to modify Singh to include the keyword further comprising at least one of a provided keyword, and a generated keyword that is related to the provided keyword and is added to the at least one keyword to suggest and enable to the advertiser to add additional keywords on which the advertiser may want to bid on.

In reference to claim 18, Singh teaches the server wherein the advertiser data further comprises of a time interval (col. 6 lines 21-47). (Note: The underlined portion of the claim is non-functional descriptive material that is not being given weight. Specifically, the type of information that is included in advertiser data does not further limit the server. The server that is used to send one type of advertiser data versus another type of advertiser data does not change with what are the contents of that advertiser data as underlined here for clarification. Again, the server is for sending advertiser data, but the type of information that is included in the advertiser data is just non-functional descriptive material that is not being given patentable weight, since no

additional server is required to send one type of advertiser data versus another type of advertiser data. The server for sending advertiser data does not change whether one or another type of advertiser data is sent.).

In reference to claim 20, Singh teaches the server, wherein the at least one selected method performed by the server includes optimization of the plurality of separate bids based on a cost per acquisition (CPA) method, comprising at least one of minimum cost for maximum acquisitions (col. 7 lines 27-40 and col. 11 lines 48-50).

In reference to claim 21, Singh teaches the server further comprising a user interface application configured to receive the advertiser data (Figures 1-6 and 9).

In reference to claim 22, Singh teaches the server wherein the user interface application further comprises a graphical interface displayable at a client (Figures 1-6 and 9), the graphical interface further comprises: an entry box configured to receive at least one of the budget (Figure 9), desired number of clicks, time zone, start time, stop time, number of clicks per day, position, relevant keywords (Figures 2, 5, and 7), advertising headline, advertising copy, and a URL; and a control means for enabling, an optimization of the received advertiser data, and the determination of the method (col. 4 lines 53-67 and col. 6 lines 1 to col. 15 lines 30).

Singh does not specifically teach the server wherein the control means enable for the generation of additional keywords. Davis teaches the server wherein the control

means enable for the generation of additional keywords (i.e. system generates synonyms for the advertiser provided keyword) (col. 20 lines 46-65). It would have been obvious to a person of ordinary skill in the art at the time of the applicant's invention to modify Singh to include control means to enable for the generation of additional keywords to suggest to the advertiser additional keywords on which the advertiser may want to consider bidding.

8. Claims 11-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Singh in view of Davis in view of Mason et al. (6,401,075 hereinafter Mason).

In reference to claims 11 and 12, Singh does not specifically teach the method further comprising: determining multiple versions of predetermined content that corresponds to the keyword; alternating between each version of predetermined content placed in the result for the sponsored search; determining a number of clicks associated with each of the multiple versions of predetermined content. Davis teaches the method further comprising: determining multiple versions of predetermined content that corresponds to the keyword (col. 17 lines 53 to col. 18 lines 36 and Figure 7); alternating between each version of predetermined content placed in the result for the sponsored search (i.e. higher ranked listings are displayed first and the ranks can change in real time based on a bid amount) (col. 17 lines 53 to col. 18 lines 36 and Figure 7); determining a number of clicks associated with each of the multiple versions of predetermined content (i.e. recording click throughs) (col. 17 lines 63 to col. 18 lines

3). It would have been obvious to a person of ordinary skill in the art at the time of the applicant's invention to modify Singh to include determining multiple versions of predetermined content that corresponds to the keyword; alternating between each version of predetermined content placed in the result for the sponsored search; determining a number of clicks associated with each of the multiple versions of predetermined content to ensure that users are provided with the version of the content that is of most interest to the users.

Singh also does not specifically teach selecting a version of predetermined content that is associated with a maximum number of clicks, wherein the selected version of predetermined content is employed to select a version of predetermined content for a subsequent result in the sponsored search and is based on a weighting factor. Mason teaches selecting a version of predetermined content that is associated with a maximum number of clicks, wherein the selected version of predetermined content is employed to select a version of predetermined content for a subsequent result in the sponsored search and is based on a weighting factor (col. 6 lines 36-65). It would have been obvious to a person of ordinary skill in the art at the time of the applicant's invention to modify Singh to include selecting a version of predetermined content that is associated with a maximum number of clicks, wherein the selected version of predetermined content is employed to select a version of predetermined content for a subsequent result and is based on a weighting factor in the sponsored search to ensure that users are provided with the most relevant results that may or may not be the highest paid results.

9. Claims 10 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Singh in view of McGregor (2002/026360 hereinafter McGregor).

In reference to claims 10 and 29, Singh does not teach the method and computer readable storage medium further comprising providing a profile that is employed to provide at least one of the keyword, the budget, and selection of the at least one method for bidding on the keyword. McGregor teaches the method and program further comprising providing a profile that is employed to provide at least one of the keyword (i.e. profile comprises of and yields keywords) (page 6 paragraphs 59-61). It would have been obvious to a person of ordinary skill in the art at the time of the applicant's invention to modify Singh to include providing a profile that is employed to provide at least one of the keyword to provide an additional method of generating keywords for advertisers who may not want to specify keywords on their own.

Claim 19 is rejected under U.S.C. 103(a) as being unpatentable over Singh in view of Davis, further in view of Mason et al. (Patent Number 6,401,075 hereinafter Mason).

In reference to claim 19, Singh does not teach providing multiple versions of an advertisement. Mason teaches providing multiple versions of an advertisement (col. 4

lines 54 to col. 5 lines 3 and col. 6 lines 33-65). It would have been obvious to a person of ordinary skill in the art at the time of the applicant's invention to modify Singh to include providing multiple versions of an advertisement to enable the advertisers to determine which advertisements are the most effective. (Note: The underlined portion of the claim is non-functional descriptive material that is not being given weight. Specifically, the type of information that is included in advertiser data does not further limit the server. The server that is used to send one type of advertiser data versus another type of advertiser data does not change with what are the contents of that advertiser data as underlined here for clarification. Again, the server is for sending advertiser data, but the type of information that is included in the advertiser data is just non-functional descriptive material that is not being given patentable weight, since no additional server is required to send one type of advertiser data versus another type of advertiser data. The server for sending advertiser data does not change whether one or another type of advertiser data is sent.).

Response to Arguments

10. **Applicant arguments**: Applicant argues that although in Singh it is true that once a flight has begun, Singh periodically adjusts bids based on current conditions, at no time does Singh teach calculating a bid based on an average cost per click inferred from historical cost per click data or based on an actual number of clicks available for a time period, as recited.

Response to arguments: The Examiner disagrees with Applicant because . table on column 10 takes into account past clicks, past bids and past costs and column 11, item 4 takes into account actual number of click throughs. So therefore contrary to Applicant's arguments, Singh teaches calculating bids based on historical cost per click as taught by table on column 10 past clicks, past bids and past costs and actual number of clicks for a time period as taught by Singh actual number of clicks for a suited time period on col. 13, lines 1 to col. 14, line 60 in order to determine a bid for the keyword.

In addition the Examiner wants to point out that the rejection has been changed from a 103 to a 102 on claims 6-7, 16, 18, 20-22 and 28 because the amendment deleted some of the features of the claims and therefore broaden the scope of the claims.

Point of contact

Any inquiry concerning this communication or earlier communications from the examiner should be directed to RAQUEL ALVAREZ whose telephone number is (571)272-6715. The examiner can normally be reached on 9:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Namrata (Pinky) Boveja can be reached on (571)272-8105. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Raquel Alvarez/
Primary Examiner, Art Unit 3682

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R.A.
8/2/2011